

of Ellis '924 with a channel extending through the peripheral rim, as taught by Ellis '491. As to claim 2, it was further contended that Ellis '924 teaches that the slits/sipes can be one, and can only be in the heel area. For the following reasons it is respectfully submitted that the claims under consideration would not have been obvious in view of the proposed combination of the two Ellis patents, and therefore the claims contain patentable subject matter.

Claim 1 as presented in the Office Action of July 23, 1996 specifically requires a lasting board mounted within the shoe's upper above the sole and extending forwardly from the heel portion toward the forefoot portion. The claim therefore defines the use of a typical lasting board of the type that extends along the shoe to completely support the wearer's foot. As is well known, the purpose of such a lasting board is to provide a firm and stable platform for the wearer's foot. Claim 1 further provides for a channel in the midsole and outsole with the channel extending through the peripheral rim dividing the heel into a pair of laterally adjacent, spaced-apart compression elements, and with the channel being separated from the upper by a connecting portion of the sole having a vertical height that is effective to present a minimal transfer of motion between the compression elements responsive to stress forces. Thus because the lasting board is defined as mounted within the upper, and because the channel is separated from the upper by the connecting portion, the channel does not penetrate into the lasting board so that the strength and supporting function of the lasting board is not diminished.

In contrast, both Ellis patents teach against the use of conventional lasting boards and thus lead away from applicant's claimed invention. The Ellis '491

patent is specifically directed to a shoe having a sole which flexes sufficiently to conform with the sole of the user's foot (page 5, line 34 to page 6, line 2) and that "... the principal function of the deformation sipes invention is to provide the otherwise rigid shoe sole with the capability of deforming easily. . . ." (page 11, lines 3-5).

The Office Action is correct in noting that Ellis '924 discloses that the slits or channels can be applied to conventional shoes (e.g. at page 8, lines 16-17; page 10, line 18 through line 2, page 11; and page 17, lines 31-33). However, these portions of the Ellis specification must be read in conjunction with the portions of the specification which explains how the deformation sipes would be incorporated into such a conventional shoe sole (page 22, line 36 through page 23, line 32). There Ellis describes that a rigid device (referring to the rigid layer 174 of Fig. 14) as well as "[a]ny other such rigid device, whether located in the midsole or on top of it, such as a conventional shoe shank providing support to the long arch of the foot . . . must also be penetrated fully by deformation sipes" (emphasis added). In such a structure the shoe would no longer have a "lasting board" of applicant's claim 1 because when a lasting board is cut through with slots or sipes it no longer has either the physical characteristics or function of a lasting board. Such a modification would thus not meet the limitation of claim 1 in which the lasting board is devoid of penetrating channels. Further in that regard, a shoe which is so modified in accordance with Ellis would no longer be a "conventional shoe" as suggested in the Office Action. The reason why Ellis requires that the deformation sipes penetrate through such a rigid layer is so that it would carry out the principal function of the deformation sipes which is to "...

provide the otherwise rigid shoe sole with the capability of deforming easily to parallel . . . the natural deformation of the human foot when load-bearing and in motion. . . ." (Ellis '924 at page 11, lines 4-8).

While Ellis '924 does contemplate that the deformation sipes may not penetrate fully through rigid shank devices, the patent describes these shank devices as providing support to the long arch of the foot in the instep area (page 23, lines 8-12). Such a shank device would not meet the limitation of a lasting board which extends from the heel portion toward the forefoot portion, as in applicant's claim 1. Such a shank does not support the heel portion, or the forefoot portion for that matter, of the shoe.

Applicant's claim 1 has been amended to specify that the lasting board is of the conventional type, rather than one penetrated by channels as in Ellis, by providing that the lasting board is devoid of penetrating channels. Both of the Ellis patents teach away from a combination with this type of structure in that the channels are specifically employed to carry out the principal feature of the invention, namely providing a shoe sole with the capability of deforming easily to parallel the natural deformation of the human foot when load-bearing and in motion. In a shoe with a lasting board which is devoid of penetrating channels there would be no such deforming capability because the lasting board would not carry out its normal function of providing a support platform for the user's foot. And this is also why Ellis requires modification of a conventional shoe incorporating a rigid device (such as a lasting board) by fully penetrating it with deformation sipes.

Accordingly, in view of the foregoing it is respectfully submitted that

claim 1 as now amended defines patentable subject matter over the art of record. Claims 2 and 4, which depend from claim 1, are submitted to be patentable for the same reasons. Accordingly, reconsideration and allowance of the claims are solicited. Should the Examining Attorney have any questions on the foregoing a telephone call to applicant's attorney at (415) 781-1989 is invited.

Respectfully submitted,



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